

REMARKS

The title of the invention has been amended to be more clearly indicative of the invention to which the claims are directed. Claim 11 has been amended. Reexamination and reconsideration of the amended application respectfully are requested.

Prior Art Rejections

The Examiner rejected claims 11 and 12 under 35 USC 102(e) as being anticipated by either of *Corisis et al.* and *Hashimoto*. Claim 11 has been amended, and it is submitted that the rejection is inapplicable to claim 11 and claim 12 depending therefrom.

The production process according to the invention defined in amended claim 11 includes the steps of:

- providing an internal interconnection on a semiconductor substrate;
- forming a surface protective film over the internal interconnection;
- forming an opening in the surface protective film to expose a portion of the internal interconnection;
- forming a bump projecting from the surface protective film on the portion of the internal interconnection exposed through the opening; and
- forming, after the formation of the bump or simultaneously with the formation of a part of the bump, a surface interconnection electrically connected to the bump, the surface interconnection having a smaller height than the bump in a predetermined region on the surface protective film except a portion thereof formed with the opening.

Thus, claim 11 has been amended to clarify that the surface interconnect is formed (1) after, or simultaneously with part of the bump, and (2) to be electrically connected to the bump. *Corisis et al.* fail to disclose forming a surface interconnection after the formation of a bump or simultaneously with the formation of a part of a bump. Rather, as shown in Figs. 3A – 3D thereof, *Corisis et al.* teach that patterns of conductors 36 are provided first, and then bumps 60 are formed, contrary to the requirement of amended claim 11. Nor does *Corisis et al.* suggest a process in which the above requirement of claim 11 would be

met. Therefore, amended claim 11 and depending claim 12 are neither anticipated by nor obvious over *Corisis et al.*, and the rejection accordingly should be withdrawn.

As described in the specification, for example in the summary of the invention, the function and advantages of the surface interconnect are related to its lower height than, and electrical connection to the bump. The Examiner relies upon *Hashimoto*'s teaching of a ground plane 346 for the surface interconnect of the invention. However, the ground plane 346 is, as shown in Fig. 20A and described at column 15, lines 12-14, not in electrical contact with the solder ball 348 (as through the connection portion 342). Moreover, it would clearly be contrary to the proper functioning of the semiconductor chip of *Hashimoto* for the ground plane to be in electrical contact with the bump 348. Therefore, amended claim 11 and depending claim 12 are neither anticipated by nor obvious over *Hashimoto*, and the rejection accordingly should be withdrawn.

Objection to Information Disclosure Statement

In the Action, the Examiner also stated that the information disclosure statement filed January 30, 2004 "fails to comply with the provisions of 37 CFR 1.87, 1.98 and MPEP Section 609 because it is a form PTO -892 (not PTO-1449)", and on that basis the Information Disclosure Statement "has been placed in the application file, but the information referred to therein has not been considered as to the merits."

It is respectfully submitted that the Examiner has incorrectly interpreted 37 CFR 1.97, 1.98 and has misapplied MPEP Section 609. Nowhere in either 37 CFR 1.97 or 37 CFR 1.98 is there a requirement that applicant submit a form PTO-1449 with an Information Disclosure Statement. Merely required in this regard (by 37 CFR 1.98(a)(1)) is "[a] list of all patents, publications, applications, or other information submitted for consideration by the Office."

The form of the list and space for notations is nowhere specified. 37 CFR 1.97 relates only to the timing of, any fees to be filed with and statements to be made in any information

disclosure statement, and that says nothing at all about a form, a list or reference copies.

Therefore, the failure to file a Form PTO-1449, but instead filing a copy of a Form PTO 892, does not violate the provisions of 37 CFR 1.97 or 37 CFR 1.98.

On the other hand, MPEP Section 609, subsections 609.02A2 and 609.05(b) state

609.02 Information Disclosure Statements in Continued Examinations or Continuing Applications [R-3]

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***IDS IN CONTINUED EXAMINATIONS OR CONTINUING APPLICATIONS**

2. Continuation Applications *>,< Divisional Applications, ** or Continuation-In-Part Applications Filed Under 37 CFR 1.53(b)

The examiner will consider information which has been considered by the Office in a parent application when examining (A) a continuation application filed under 37 CFR 1.53(b) ** (B) a divisional application filed under 37 CFR 1.53(b) ** or (C) a continuation-in-part application filed under 37 CFR 1.53(b). A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.

If resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in 37 CFR 1.98(a)(1). Applicants are strongly discouraged from submitting a list that includes copies of PTO/SB/08 (PTO-1449) or PTO-892 forms from other applications. A completed PTO/SB/08 or PTO-1449 form from another application may already have initials of an examiner and the application number of another application. This information will likely confuse the record. Furthermore, when the spaces provided on the form have initials of an examiner, there are no spaces available next to the documents listed for the examiner of the subsequent application to provide his or her initials, and the previously relevant initials may be erroneously construed as being applied for the current application.

609.05(b) Complying Information Disclosure Statements [R-3]

The information contained in information disclosure statements which comply with both the content requirements of 37 CFR 1.98 and the requirements, based on the time of filing the statement, of 37 CFR 1.97 will be considered by the examiner. Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449

or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

Examiners must consider all citations submitted in conformance with the rules **, . . .

From the above, it is deemed quite clear that

- (1) the Examiner must consider all references cited in an IDS satisfying the requirements of 37 CFR 1.97 and 1.98; and
- (2) If the list of cited references is not provided on a form PTO 1449, the references may not be listed on the resulting patent, but he must nevertheless consider them.

Therefore, consideration of the IDS filed January 30, 2004 respectfully is requested.

Based on the above, it is submitted that the application is in condition for allowance, and such a Notice, with allowed claims 11 and 12, earnestly is solicited.

Respectfully submitted,

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Date


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